

Applicant : Michael J. Taylor et al.
Serial No. : 09/970,532
Filed : October 3, 2001
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Attorney's Docket No.: 08411-018002 / ISURF 02556

REMARKS

Applicants respectfully requests entry of the remarks submitted herein. No claims were amended herein. Reconsideration of the pending application is respectfully requested.

Objections

Claims 41-44 stand rejected under 37 CFR §1.75(c), as the Examiner asserted that those claims are not proper dependent claims because they fail to further limit the subject matter of a previous claim. Applicants respectfully traverse this objection.

The Examiner asserted that claims 41-44 don't further limit the subject matter of the previous claims since the previous claims recite a "bovine" TNF-R1.

Claims 41-44 are directed toward the source of the TNF. The Examiner is correct that claims 29, 30, 32, and 33 recite "bovine TNF-R1." Claims 29, 30, 32, and 33, however, recite that the TNF-R1 polypeptide binds "TNF," while claims 41-44 further limit the "TNF" recited in claims 29, 30, 32, and 33 to "bovine TNF." Contrary to the Examiner's statement, claims 41-44 are proper dependent claims and do, in fact, further limit the claims from which they depend. Therefore, Applicants respectfully request that the objections to claims 41-44 under 37 CFR §1.75(c) be withdrawn.

The 35 U.S.C. §112 Rejections

Claims 46-59 stand rejected under 35 U.S.C. §112, first paragraph, as the Examiner asserted that those claims fail to comply with the written description requirement. Applicants believe the Examiner intended to reject claims 45-58 (instead of 46-59), and note that page 3 of the Office Action indicates that claims 45-58 are rejected. This rejection is respectfully traversed with regard to claims 45-58.

The Examiner asserted that the lengths recited in claims 45-58 are not present in the specification, and concluded, therefore, that the fragment sizes are new matter.

In the Response filed on January 15, 2004 in which new claims 45-58 were added, Applicants pointed to support in the specification for the recited lengths. Applicants indicated

that support for claims 45-58 can be found, for example, at page 6, line 17 through page 7, line 6, and in Figure 1. Applicants provide the following information from the specification to support claims 45-58.

For disclosure of the 545 nucleotide length recited in claim 46, see, for example, page 6, line 22 ("from about nucleotide 378 to about nucleotide 923..."; 923 – 378 = 545). For disclosure of the 75-nucleotide length recited in claims 48, 50, 52, 54, and 56, see, for example, the dashed underline region in Figure 1.

The 325 nucleotide length recited in claim 45, the 30 nucleotide length recited in claim 47, the 25 nucleotide length recited in claims 49 and 51, the 24 nucleotide length recited in claim 53, and the 23 nucleotide length recited in claim 55 represent fragments that are at least one nucleotide longer than the longest homologous segment at the recited percentage of sequence identity in alignments of the bovine and human TNF-R1 nucleic acid sequences. Applicants were in possession of the results of such alignments at the time of filing (see, for example, page 5, line 27 through page 6, line 16 and page 14, lines 1-4).

In addition, the 30 amino acid length recited in claim 57 and the 21 amino acid length recited in claim 58 represent fragments that are one amino acid longer than the longest homologous segment resulting from alignments of the bovine and human TNF-R1 polypeptide. As indicated above, Applicants were in possession of the results of such alignments at the time of filing (see, for example, page 5, line 27 through page 6, line 16 and page 14, lines 1-4).

Applicants have sufficient written description support for the fragments of the claimed length, and Applicants were clearly in possession of the claimed invention at the time of filing. In view of the remarks herein, Applicants respectfully request that the rejection of claims 45-58 under 35 U.S.C. §112, first paragraph, be withdrawn.

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CONCLUSION

The Examiner indicated that claims 29-40 and 59-62 are allowed. In view of the remarks herein, Applicants respectfully request that claims 41-58 also be allowed. Please apply any charges or credits to Deposit Account 06-1050.

Respectfully submitted,

Date: June 17, 2004

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